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10/583,231	05/17/2007	Neil Richard Birkett	F3347(C)	8228

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EXAMINER

WILLIAMS, LELA

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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12/14/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/583,231	Applicant(s) BIRKETT ET AL.	
	Examiner LELA S. WILLIAMS	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-12,14-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2,7-12,14-18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Please note the examiner of record has been changed. The new examiner is Lela Williams.

Applicants' amendment filed on June 29, 2009 has been fully considered. In light of the new grounds of rejections set forth below, the following action is non-final.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-2, 7-12, 14-18, and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

Regarding claim 1, applicant included the limitation “which is not a calcium carbonate” and the “system does not contain citric acid”. The cited phraseology clearly signifies a “negative” or “exclusionary” limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed

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introduce new concepts and violate the description requirement of 35 USC 112, first paragraph, *Ex Parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453.

The insertion of the above phraseology as described above positively excludes calcium carbonate and citric acid. As support for the above amendment, applicants point to page 15, lines 13-18 which shows that the use of calcium carbonate results in overrun that is much less preferred and to page 16, lines 4-11 which discloses that the use of citric acid produces less than preferred result with respect to pH and overrun. However, these few specific examples do not provide support to exclude both calcium carbonate and citric acid from the present claims.

Claims 8, 11, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, there is no aerated product of claim 1, just a premix. As written the aerated product stated in claim 1 is produced if or when the premix is mixed with water, which is not a limitation of the claim.

Regarding claims 11 and 12, it is not clearly stated how one arrives at an aerated confection product of ice cream with just acid, carbonate, stabilizer, and water. One of ordinary skill in the art would not conclude an ice cream product from the stated ingredients.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 1, 2, 7- 12, 14-18, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nayyar et al. U.S. Pat. No. 5,853,785 in view of Schenk U.S. Pat. No. 4,206,244 and Kimura JP 2001-346518.

Regarding claims 1,2,7- 9, 21 Nayyar discloses a dry confectionery premix which comprises a carbon dioxide generating composition, i.e., a food grade acid mixed with sodium carbonate (col. 4, lines 4-15) and a stabilizer i.e., gums (col. 3, line 61). Although ascorbic or succinic acid is not explicitly disclosed, they are well know and commonly used in the art as food acids, as shown in the dry premix of Schenk (col. 2, line 35) and Kimura [0004]. Nayyar discloses the amount of sodium bicarbonate to range from 0.2-2%, but is silent on the amount of food grade acid used. Although the examples of the reference show an amount of acid which would result in a ratio outside of the presently claimed amount, however considering the reference as a whole would lead a person of ordinary skill in the art to utilize an amount of food acid effective for the release of carbon dioxide, as stated in col. 4, line 12. Therefore it would have been obvious to one of ordinary skill in the art to choose food acid, and in effective amount, including that presently claimed to utilize for a carbon dioxide generating composition contingent upon the desired taste and pH level of the final product.

The recitation in the claim that the premix composition is “for preparing an aerated confectionery product” is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

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It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Nayyer disclose a dry confectionery premix composition as presently claimed, it is clear that the composition of Nayyer would be capable of performing the intended use, i.e. preparing an aerated confectionery product, presently claimed as required in the above cited portion of the MPEP.

Furthermore, the functional language of the claim i.e. "such that when the premix is mixed with water to give a final solids content of at least about 20 wt%, an aerated confectionery product is formed, in the absence of mechanical aeration, having an overrun of at least about 30% (or at least about 70%) and a pH of greater than about 5.4" only applies if or when the premix composition is mixed with water. It is noted that prior art premix, being of the same composition is expected to meet the aforementioned limitation when mixed with water as presently claimed.

Regarding claims 10 -12, Nayyar discloses a product which is particulate (col. 2, lines 47-50) and is a chilled (col. 1, line 56). The reference does not disclose the frozen confectionary product as ice cream. Kimura discloses an ice cream. One of ordinary skill would have been motivated to modify Nayyar for the purpose of producing ice cream especially since Nayyar discloses using milk as the liquid mixed with the premix and freezing it for a prolonged period (col. 1, line 65).

Regarding claims 14-18, Nayyar discloses a method of preparing a confectionery product which comprises mixing the premix, as applied to claim 1 above, with an aqueous liquid to give a final solid content of at least 20% (col. 4, lines 57-61) the product is aerated by shaking

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(col. 5, line 20) and chilled to a temperature of -6.5°C (col. 1, line 49). It is noted that prior art product, being of the same composition and produced in the absence of mechanical aeration, is expected to meet the pH value presently claimed, as well as the overrun limitation of at least about 30% (or at least about 70%). The reference does not disclose the frozen confectionary product as ice cream. Kimura discloses an ice cream. One of ordinary skill would have been motivated to modify Nayyar for the purpose of producing ice cream especially since Nayyar discloses using milk as the liquid mixed with the premix and freezing it for a prolonged period (col. 1, line 65).

Response to Arguments

6. Applicant's arguments filed on June 29, 2009 with respect to claims 1-3, 7-9, 11 and 13-15 with respect to Nayyar et al. U.S. Pat. No. 5,853,785 have been fully considered and are not persuasive. Applicant's arguments with respect to Cain et al. (EP1245156), in view of Hara (EP0191487) and Nayyar et al. in view of rahabadvisor.pathnet.org, and Nayyar et al. in view of Cain et al. (EP1245156), have been considered but they are moot in view of the new grounds of rejections set forth above.

Applicant argues that Nayyar teaches using citric acid in examples 1-2 and 4-6 which would result in overrun outside the scope of the present claims and is silent regarding ascorbic acid or succinic acid. The examples are just a few preferred embodiments of Nayyar. Further, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." In re Courtright, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, "nonpreferred disclosures can be used. A

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nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” In re Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of the reference as a whole clearly broadly discloses the use of food grade acids and does not require the use of citric acid. While it is agreed that there is no explicit disclosure of ascorbic acid or succinic acid as presently claimed, this is why Nayyar is now rejected in combination with Schenk and Kimura which teach ascorbic acid and succinic acid are well know and commonly used in the art as food acids.

Applicant also argues that “*Nayyar is directed to a different objective technical problems from applicants' invention. The goal of Nayyar is a dry mix to make slush beverages... and not to aerate a frozen confection such as ice cream to an overrun of at least 30%.*” It is agreed that there is no explicit disclosure of ice cream; however Nayyer does disclose an aerated frozen confection using milk as the liquid mixed with the premix and freezing it for a prolonged period, which would render ice cream an obvious product to one of ordinary skill. Nayyer’s premix, is expected to meet the limitation of an overrun of at least 30%, being that it is the same composition as presently claimed.

Applicant points to comparative data for the explanation of unexpected results; however with respect to citric acid the data is not persuasive given that there is only proper side-by-side comparison between example 2 and (comparative) example 4. Example 4, which utilizes citric acid, achieves the claimed overrun and pH. Therefore, there is no disclosure that using ascorbic acid results in unexpected or surprising results. With respect to the calcium carbonate, the data is not persuasive (example 1 vs. example 6) given that the data is not commensurate in scope with the scope of the present claims given that there is only data provided for one amount of acid and

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one amount of carbonate. As set forth in MPEP 716.02(d), whether unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support”. In other words, the showing of unexpected results must be reviewed to see if the results occurred over the entire claimed range, *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LELA S. WILLIAMS whose telephone number is (571)270-1126. The examiner can normally be reached on Monday to Thursday from 7:30am-5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LELA S. WILLIAMS
Examiner, Art Unit 1794
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/Callie E. Shosho/
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